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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,081	04/12/2000	Florencio Zaragoza Dorwald	5390.200-US	5691

7590 06/25/2004

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EXAMINER

LIU, HONG

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/548,081

Applicant(s)

DORWALD ET AL.

Examiner

Hong Liu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 102-107, 110-112, 114, 115, 121, 122 and 124-132 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 102-105 is/are rejected.
- 7) ☒ Claim(s) 106, 107, 110-112, 114, 115, 121, 122 and 124-132 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claims 102-107, 110-112, 114-115, 121-122 and 124-132 are pending in this application.

This action is in response to the applicants' amendment and reply filed on April 30, 2004.

Response to Arguments

Applicants' arguments and amendments filed on April 30, 2004 have been fully considered but they are not persuasive. Rejection of Claims 102-105 under 35 U.S.C. § 102(b) as anticipated by Stocker et al. is maintained for the reason given below.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The rejection of claims under 35 U.S.C., 112, first paragraph, is hereby withdrawn in view of applicant's argument and reference to the disclosure on page 36 of the specification.

The rejection of claims under 35 U.S.C., 112, second paragraph, is hereby withdrawn in view of applicant's amendment.

Claim Rejections - 35 USC § 102

Claims 102-105 remain rejected under 35 U.S.C. 102(b) as being unpatentable over Stocker et al. Applicants' arguments have been fully considered but they are not

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persuasive. Applicants argue that the position of the double bond in the imidazole ring is fixed and that the Stocker's compound has the nitrogen in the 5 position and compounds of the Formula I have the nitrogen of the pyridine ring in the 6 position. The double bond in the imidazole ring does not seem to be fixed because when R1 is hydrogen, the proton of one nitrogen may transfer to the other nitrogen, resulting in a compound that is a tautomer of the original compound. It is the tautomerized form of the instant compound that is anticipated by the reference compound. Because instant compounds and their tautomers can exist in equilibrium, the instant compounds are still considered to have the same chemical structure as the reference compound, that is, anticipated by the reference.

Conclusion

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

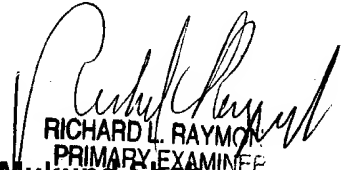
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (571) 272-0669. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisors, Mukund Shah can be reached at (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 358-1235.


RICHARD L. RAYMON
PRIMARY EXAMINER
Mukund Shah
Art Unit 1624
Supervisory Patent Examiner
Art Unit 1624

hl
June 1, 2004